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09/264,171 03/05/99 STROH

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TM01/1129

EXAMINER

AKERS, G

ART UNIT

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2164

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/264,171

Applicant(s)  
Stroh et al

Examiner  
Geoffrey Akers

Group Art Unit  
2164



☒ Responsive to communication(s) filed on Mar 5, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-34 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☒ Claim(s) 1-34 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

1. Claims 1-34 have been examined.

#### *Specification*

2. The abstract of the disclosure is objected to because it is more than 250 words long. Correction is required. See MPEP § 608.01(b).

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 30-31 are rejected under 35 USC 102(e) as anticipated by Ordish(US Pat. No: 5,727,165).
5. As per claim 30 Ordish teaches a financial instrument comprising a pre-approved bill of exchange accepted in advance by a buyer, payable to a seller, and evidencing willingness of the buyer to pay the seller a sum certain of money at a specific point in future time, such time to be determined by a pre-specified triggering event(col 4 lines 6-17)(col 4 lines 29-35).

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6. As per claim 31 Ordish teaches a financial instrument according to claim 30 and being in human-readable form or machine-readable form(col 4 lines 6-17)(col 4 lines 29-35).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-29,32-34 are rejected under 35 USC 103(a) as unpatentable over Ordish et al(US Pat. No: 5,727,165) and further in view of Lindsey(US Pat. No: 5,285,383).

9. As per claim 1 Ordish teaches a method for moving goods and services from a seller to a buyer and involving the transport of goods or a report or the like document while assuring the movement of a payment for said goods and/or services from said buyer to said seller, comprising the steps of said buyer executing a first document having indicia purporting to legally bind the buyer upon the happening of an event and sending to said seller said first document having indicia purporting to legally bind the buyer upon the happening of an event(col 4 lines 6-17)(col 4 lines 29-35), and said buyer executing a second document having indicia indicating information describing a commercial transaction and sending to said seller said second document having indicia indicating information describing a commercial transaction(col 4 lines 37-50).Ordish teaches an offer matching system between a buyer and a seller. Ordish fails to teach

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notifying a financial institution of a consummated trade. Lindsey teaches said seller notifying a financial institution respecting the execution and sending of said first document having indicia purporting to legally bind the buyer upon the happening of an event and said second document having indicia indicating information describing a commercial transaction(col 20 lines 63-col 21 line 3)(col 21 line 27-56)(Fig 3C/100-106). Lindsey teaches said financial institution transmitting to said seller a transaction approval(col 21 lines 41-55). Lindsey also teaches said seller causing said event to occur and said seller sending to the buyer's transaction interface a third document, entitling the holder of said third document to said goods(col 21 lines 55-59)(Fig 1) and a fourth document having indicia purporting to legally bind the buyer, upon execution of the fourth document and the happening of said event(col 22 lines 22-45)(Fig 3d/148) said fourth document being presented to said buyer, and said buyer executing said fourth document(Fig 3d/134) said executed fourth document being exchanged for said third document, whereby said executed fourth document is in the possession of the buyer's transaction interface, and said third document is in the possession of the buyer said seller providing said first document to said financial institution(col 21 lines 1-3), and said financial institution issuing a fifth document purporting to obligate said financial institution to pay said seller a second payment(Fig 3d/136). It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to describe an installment sale as a form of deferred sale where all funds are not paid initially, and subsequent funds are paid from an issuer as a bank.

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10. As per claim 2 Lindsey teaches a method as in claim 1, further comprising the steps of said buyer's transaction interface advising said financial institution of the receipt by said buyer's transaction interface of said third document(col 21 lines 1-3)(col 21 lines 51-59)(Fig 2/58).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to teach the purchase and subsequent ownership of title by the buyer.

11. As per claim 3 Lindsey teaches a method as in claim 2, further comprising the steps of said buyer's transaction agent paying said financial institution a third payment and said financial institution paying a fourth payment to the holder of said fifth document(Fig 3d/134/146/136).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to describe an installment or deferred sale where all funds are not paid initially from a designated agency as a bank at the buyer's authorization.

12. As per claim 4 Lindsey teaches a method as in claim 1, wherein said buyer notifies an administrator respecting the execution and sending of said first document having indicia purporting to legally bind the buyer upon the happening of an event and said second document having indicia indicating information describing a commercial transaction(col 22 lines 54-col 23 line 12)(Fig 3d/140/142/144/154).

13. As per claim 5 Lindsey teaches a method as in claim 1, wherein said event is the transporting said goods or performing said services and embodying said performance in a report or other like

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document or thing(col 24 lines 49-col 25 line 13)(Fig 3E).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above.The motivation for this is to record the transaction.

14. As per claim 6 Lindsey teaches a method as in claim 1, wherein said fourth document is a second of exchange(col 22 lines 34-40).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to specify the identity of the cited documents in the transaction.

15. As per claim 7 Lindsey teaches a method as in claim 1, wherein said third document is an invoice(Fig 3d/154).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to specify the identity of the cited documents in the transaction.

16.As per claim 8 Lindsey teaches a method as in claim 1, wherein said second document having indicia indicating information describing a commercial transaction is a pro-forma invoice(Fig 3D/154)It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to identify documents in the transaction.

18. As per claim 9 Lindsey teaches a method as in claim 1, wherein the event which triggers the legal obligation of said seller is said seller's parting with physical control of said goods or said seller's performing said services(Fig 3G/216). It would have been obvious to one skilled in the art

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at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to define ownership transfer in the transaction process.

19. As per claim 10 Ordish teaches a method as in claim 1, wherein said first document is a first of exchange(col 4 lines 6-35).

20. As per claim 11 Ordish teaches a method as in claim 1, wherein said first document is a first of exchange(col 4 lines 6-35). Ordish fails to teach that execution of said first document is done by ink signature. It would have been obvious to one skilled in the art at the time of the invention to utilize ink as a permanent means of recording a legally binding signature. The motivation for this is the preservation of the sign of approval in a transaction.

21. As per claim 12 Ordish teaches a method as in claim 1, wherein said first document is a first of exchange(col 4 lines 6-35). Ordish fails to teach that execution of said first document is done by facsimile signature. It would have been obvious to one skilled in the art at the time of the invention to utilize a facsimile as a permanent means of recording a legally binding signature. The motivation for this is the preservation of the sign of approval in a transaction.

22. As per claim 13 Ordish teaches a method as in claim 1, wherein said first document is a first of exchange(col 4 lines 6-35). Ordish fails to teach that execution of said first document is done by electronic signature. It would have been obvious to one skilled in the art at the time of the invention to utilize an electronic means as a permanent means of recording a legally binding signature. The motivation for this is the preservation of the sign of approval in a transaction.



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23. As per claim 14 Lindsey teaches a method as in claim 13, describing electronic confirmation of sale(Fig 2G/200-220). Lindsey fails to teach wherein said electronic signature is the product of a confidential algorithm specific to the buyer.It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation is to describe a user-specific electronic signature unique to the buyer in a commercial transaction.

24. As per claim 15 Lindsey teaches a method as in claim 14, wherein said confidential algorithm is responsive to an identification number associated with the buyer and the date of signature(col 26 lines 21-24)(Fig 2/56).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above.The motivation for this is to describe a unique signature to a user/buyer.

25.As per claim 16 Ordish teaches a method as in claim 1, wherein said indicia are printed with ink on a sheet of paper or other similar material(Fig 6)(col 7 lines 6-14)(Fig. 1/S8/S9/T8/T9).

26. As per claim 17 Ordish teaches a method as in claim 1, wherein said indicia and said document are electronic(col 7 lines 6-14)(Fig 1/8/9).

27. As per claim 18 Ordish teaches a method for moving goods and/or services from a seller to a buyer and involving transport of goods or a report or other like document or thing, while assuring the movement of a payment for said goods and/or services from said buyer to said seller, comprising the steps of said buyer executing a first document having indicia purporting to legally bind the buyer upon the happening of an event and sending to said seller said first document

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having indicia purporting to legally bind the buyer upon the happening of an event(col 4 lines 6-17)(col 4 lines 29-35) and said buyer executing a second document having indicia indicating information describing a commercial transaction and sending to said seller said second document having indicia indicating information describing a commercial transaction(col 4 lines 37-50). Ordish teaches an offer matching system between a buyer and a seller. Ordish fails to teach notifying a financial institution of a consummated trade. Lindsey teaches said seller notifying a financial institution respecting the execution and sending of said first document having indicia purporting to legally bind the buyer upon the happening of an event and said second document having indicia indicating information describing a commercial transaction(col 20 lines 63-col 21 line 3)(col 21 lines 27-56)(Fig 3C/100-106). Lindsey teaches said financial institution transmitting to said seller a transaction approval(col 21 lines 41-55). Lindsey also teaches said seller causing said event to occur and said seller sending to the buyer's transaction interface a third document, entitling the holder of said third document to said goods(col 21 lines 55-59)(Fig 1) and a fourth document having indicia purporting to legally bind the buyer, upon execution of the fourth document and the happening of said event(col 22 lines 22-45)(Fig 3d/148) said fourth document being presented to said buyer, and said buyer executing said fourth document(Fig 3d/134) said executed fourth document being exchanged for said third document, whereby said executed fourth document is in the possession of the buyer's transaction interface, and said third document is in the possession of the buyer said seller providing said first document to said financial institution(col 21 lines 1-3), and said financial institution issuing a fifth document

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purporting to obligate said financial institution to pay said seller a second payment(Fig 3d/136).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to describe and installment sale as a form of deferred sale when all funds are not paid initially, and subsequent funds are paid from an issuer as a bank in a commercial transaction for goods.

28. As per claim 19 Lindsey teaches a method as in claim 18,wherein said seller causing said event to occur and said seller sending to the buyer's transaction interface a third document, entitling the holder of said third document to said goods(col 21 lines 55-59)(Fig 1) and a fourth document having indicia purporting to legally bind he buyer, upon execution of the fourth document and the happening of said event(col 22 lines 22-45)(Fig 3d/148) said fourth document being presented to said buyer, and said buyer executing said fourth document(Fig 3d/134) said executed fourth document being exchanged for said third document, whereby said executed fourth document is in the possession of the buyer's transaction interface, and said third document is in the possession of the buyer said seller providing said first document to said financial institution(col 21 lines 1-3), and said financial institution issuing a fifth document purporting to obligate said financial institution to pay said seller a second payment(Fig 3d/136). Lindsey fails to teach that the financial institution has implemented an insurance feature triggered upon the failure of the buyer to make a payment. It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above including the financial institution implementing an insurance feature to protect against default in the

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purchase. The motivation for this is to describe an installment sale as a form of purchase with the financial institution protecting against default on the part of the buyer in the electronic transaction system for goods.

29. As per claim 20 Ordish teaches a method for electronically monitoring and controlling the movement of goods and/or services from a seller to a buyer and involving transport of goods or a report or other like document or thing of value, and electronically executing a payment for said goods and/or services from said buyer to said seller, wherein the buyer, the seller, a financial institution, and a buyer's transaction interface are electronically connected over an information transport system, comprising the steps of: (a) said buyer electronically sending to said seller a first packet or packets of information performing the function of a first conventional executed document having information purporting to legally bind said buyer upon the happening of an event (col 4 lines 6-17) (col 4 lines 29-35) and said buyer electronically sending to said seller a second packet or packets of electronic information performing the function of a second conventional executed document having information describing a commercial transaction (col 4 lines 37-50). Ordish fails to teach notifying a financial institution of a consummated trade.

Lindsey teaches said seller notifying a financial institution respecting the execution and sending of said first document having indicia purporting to legally bind the buyer upon the happening of an event and said second document having indicia indicating information describing a commercial transaction (col 20 lines 63-col 21 line 3) (col 21 line 27-56) (Fig 3C/100-106).

Lindsey teaches said financial institution transmitting to said seller a transaction approval (col 21

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lines 41-55). Lindsey also teaches said seller causing said event to occur and said seller sending to the buyer's transaction interface a third document, entitling the holder of said third document to said goods(col 21 lines 55-59)(Fig 1) and a fourth document having indicia purporting to legally bind the buyer, upon execution of the fourth document and the happening of said event(col 22 lines 22-45)(Fig 3d/148) said fourth document being presented to said buyer, and said buyer executing said fourth document(Fig 3d/134) said executed fourth document being exchanged for said third document, whereby said executed fourth document is in the possession of the buyer's transaction interface, and said third document is in the possession of the buyer said seller providing said first document to said financial institution(col 21 lines 1-3), and said financial institution issuing a fifth document purporting to obligate said financial institution to pay said seller a second payment(Fig 3d/136).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above.The motivation for this is to describe an installment sale as a form of deferred sale where all funds are not paid initially, and subsequent funds are paid from an issuer as a bank.

30.As per claim 21 Lindsey teaches a method as in claim 20, further comprising the steps of said buyer's transaction interface sending to said financial institution a sixth packet or packets of electronic information advising said financial institution of the receipt by said buyer's transaction interface of said third packet or packets of electronic information(col 26 lines 21-25)(col 22 lines 28-45).It would have been obvious to one skilled in the art at their time of the invention to

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combine Ordish in view of Lindsey to teach the above. The motivation for this is to define the transaction process in a purchase/delivery /deferred installment sale system.

31. As per claim 22 Lindsey teaches a method as in claim 21, further comprising the steps of said buyer's transaction interface sending a seventh packet or packets of electronic information to said financial institution, said seventh packet or packets of electronic information representing a third payment and said financial institution sending an eighth packet or packets of electronic information representing a fourth payment to the holder of rights created by said fifth packet or packets, electronic information(col 22 lines 28-45).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to define an installment sale in the goods.

32.As per claim 23 Lindsey teaches a method as in claim 22, wherein said financial institution is the seller's bank, and said buyer's transaction interface is in the buyer's bank(Fig 3C/122/120/124)(Fig 3C/100).It would have been obvious to one skilled in the art at the time of the inventio to combine Ordish in view of Lindsey to teach the above. The motivation for this is to describe the arrangements with the financial institutions in a buyer-seller transaction system.

33. As per claim 24 Lindsey teaches a method as in claim 22, wherein said first packet or packets of or chronic information performs the function of a first of exchange, said second packet or packets of electronic information performs the function of a pro-forma invoice(col 20 line 63-col 21 line 3), said third packet or packets of electronic information performs the function of an invoice(Fig 3D/154) and said fourth packet or packets of electronic information performs the

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function of a second of exchange(col 22 lines 34-54).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to teach the division of a transaction into component electrical packets for processing.

34. As per claim 25 Lindsey teaches a deferred sale program(col 22 lines 34-36), which may include a government loan program which may be in installments.Lindsey fails to teach a method as in claim 1, wherein said second payment is said payment less a service fee.It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above whereby in a deferred sales program there is more than one payment and these payments may include a service fee.The motivation for this is to permit the generation of revenue from fees for a sales program where payments are deferred or made in installments.

35.As per claim 26 Lindsey teaches a trade finance method for financing the sale of a traded product supplied by a seller to a buyer wherein, prior to supply of the traded product by the seller, the buyer provides to the seller or the seller's agent, a buyer-executed payment draft ordering payment for the traded product to be made at maturity of a term, wherein the term is triggered by an event occurring subsequently to buyer execution of the draft(col 20 line 63-col 21 line 3)(Fig 3C)(col 21 line 26-col 22 line 21). It would have been obviopus to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to teach a trade finance program.

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36. As per claim 27 Lindsey teaches a method according to claim 26 wherein the payment draft is paid in funds as a money draft(col 23 lines 34-36). Lindsey fails to teach specifically use of a prerelease payment draft, prerelease in anticipation of a purchase.It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach use of a prelease payment draft in view of use of a money draft. The motivation for this is to teach a draft released in anticipation of a purchase.

37. As per claim 28 Lindsey teaches a method according to claim 26 wherein the payment draft is paid in funds as a money draft(col 23 lines 34-36). Lindsey also teaches the use of a deferred sales progrma(Fig 3D)(col 22 lines 34-36).It would have been obvious to one skilled in the art art the time of the invention to combine Ordish in view of Lindsey to teach utilizing installments in the deferred sales program to teach the use of a first bill of exchange and the buyer executing a second bill of exchange for the amount of the traded product prior to receiving the traded product, and wherein the first and second bills of exchange are mutually extinguishable.The motivation for this is to teach installment sales.

38. As per claim 29 Lindsey teaches a method according to claim 28 comprising substituting a banker's acceptance for the first bill of exchange(col 22 line 5)(col 23 lines 29-35).It would have been obvious to one skilled in the art at thetime of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to teach a method of payment for goods.



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39. As per claim 32 Lindsey teaches a method of trade financing according to claim 26 effected by computer implemented software(col 21 lines 26-54). It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to describe a computer implemented method of trade financing for the transactions for goods.

40. As per claim 33 Lindsey teaches a method financing a sale of a traded product from a seller to a buyer comprising acceptance by the buyer of a first payment draft ordering payment for the traded product to be made at a maturity date subsequent to the date of acceptance(col 22 lines 34-36) and delivery of the buyer-accepted first payment draft to the seller or the seller's agent(col 23 lines 34-36) and retention by the seller or the seller's agent of the buyer-accepted first payment draft as collateral for payment for the traded product and acceptance by the buyer of a second payment draft ordering payment for the traded product to be made at a maturity date no later than the first draft maturity date wherein the first and second drafts are interdependent in that each draft is payable only if the other draft is unpaid(col 21 lines 1-3) and presentation of the second payment draft to the buyer or the buyer's agent to collect payment for the traded product(col 23 lines 34-36). It would have been obvious to one skilled in the art at the time of the invention at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to address deferred sales and collateralized loan programs for goods utilizing electronic transactions.

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41. As per claim 34 Lindsey teaches a method according to claim 33 wherein the first payment draft has a maturity date determined as a fixed period subsequent to an event and the second payment draft has the same maturity date as the first payment draft and wherein the first and second payment drafts are mutually extinguishable, payment of one extinguishing the other(Fig 3C)(col 21 lines 1-3).It would have been obvious to one skilled in the art at the time of the invention to combine Ordish in view of Lindsey to teach the above. The motivation for this is to address a collateral loan.

### *Conclusion*

42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Odom teaches a real time network exchange with seller specified exchange parameters

-Clark teaches an electronic delivery system for financial services

-Popolo teaches a system for matching buyers and sellers of spot metals

-Rickard teaches a method for negotiations between parties

-Silverman teaches a method for distributed matching

-Solomon teaches an interactive system for negotiating sales of goods/services

-Hartheimer teaches a financial exchange system having automated recovery/rollback of unacknowledged orders

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-Giovannoli teaches a computerized quotation system

-Fuhrer teaches a system for enhanced trading support

Any questions regarding this communication should be addressed to the examiner, Dr. Geoffrey R. Akers, P.E., who can be telephoned at (703)-306-5844 between the hours of 6:30 AM and 5:00 PM Monday through Friday. If attempts to contact the examiner are unsuccessful, the examiner's supervisor, Mr. Vincent Millin may be reached at (703)-308-1065.

GRA

October 19,2000

  
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